

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN TECHNOLOGIES, INC.

Petitioner

v.

NOVEN PHARMACEUTICALS, INC.

Patent Owner

Case No. IPR2018-00173

U.S. Patent No. 9,724,310

**JOINT MOTION TO EXPUNGE EXHIBIT 2024
UNDER 37 C.F.R. § 42.56**

I. INTRODUCTION

Under 37 C.F.R. § 42.56 and pursuant to authorization received by email from the Board on September 24, 2018, Petitioner Mylan Technologies, Inc. and Patent Owner Noven Pharmaceuticals, Inc. (collectively, the “Parties”) jointly move to permanently expunge from the record Exhibit 2024 (“Binding Settlement Term Sheet between Petitioner and Patent Owner”) in its entirety. Exhibit 2024 discloses and discusses business confidential information relating to the settlement agreement between the Parties, which could be improperly used by competitors to gain unfair business and competitive advantages with customers in the marketplace.

If the Board is not inclined to grant this motion, the Parties respectfully request a conference call with the Board to discuss the issues raised in this motion.

II. AUTHORIZATION FOR THE MOTION

On September 13, 2018, the Board issued an Order granting the Parties’ joint motion to terminate due to settlement prior to institution. Paper 15. The Parties contacted the Board by email on September 24, 2018, to request authorization to move to permanently expunge from the record the Binding Term Sheet (Exhibit 2024) submitted with the Joint Motion to Terminate (Paper 12), and the Board responded by email on the same day to authorize the Parties to move to expunge Exhibit 2024.

III. IDENTIFICATION OF THE EXHIBIT TO BE EXPUNGED

Exhibit 2024 was filed jointly with a Request under 37 C.F.R. § 42.74(c) (Paper 13) to keep Exhibit 2024 separate from the files involved in the IPR. In the Order granting the Parties' Joint Motion to Terminate, the Board also granted the Parties' Request under 37 C.F.R. § 42.74(c) to keep Exhibit 2024 separate from the patent file (Paper 15, 3).

IV. REASONS FOR ENTITLEMENT TO RELIEF

The Board's rules "aim to strike a balance between the public's interest in maintaining a complete and understandable file history and the parties' interest in protecting truly sensitive information." Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012).

In the present case, Exhibit 2024 is not required for "a complete and understandable file history." A settlement was reached between the Parties and the IPR has been terminated prior to the issuance of a final written decision. Maintaining Exhibit 2024 as part of the record does not benefit the public because the Board's Order granting the Parties' Joint Motion to Terminate (Paper 15) can be fully understood by the public in its own right and without the confidential details of the Parties' Binding Term Sheet (Exhibit 2024).

Whereas the public would not benefit from revealing the confidential information in Exhibit 2024, the Parties have a legitimate interest in protecting the

truly sensitive information contained therein, and could be placed at a competitive disadvantage if, for example, the confidential information is accessed under 37 C.F.R. §§ 42.74(c)(1) or 42.74(c)(2).

Further, the Board has already ruled upon the information in Exhibit 2024 and determined that the information is confidential (Paper 15, 3), so good cause has already been found by the Board that the information should not be made available to the public.

V. CONCLUSION

For the reasons set forth above and in the previously granted Request under 37 C.F.R. § 42.74(c) (Paper 13), the Parties respectfully request that Exhibit 2024 be expunged from the record.

Respectfully submitted,

Dated: September 26, 2018

/ Steven W. Parmelee /
Steven W. Parmelee
Registration No. 31,990

Michael T. Rosato
Registration No. 52,182

Jad A. Mills
Registration No. 63,344

Counsel for Petitioner
Wilson, Sonsini, Goodrich, & Rosati

/ Courtenay C. Brinckerhoff /
Courtenay C. Brinckerhoff
Registration No. 37,288

Jason N. Mock
Registration No. 69,186

Counsel for Patent Owner
Foley & Lardner LLP

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Joint Motion to Expunge under 37 C.F.R. § 42.56** is being served on September 26, 2018, by filing it through the PTAB E2E System as well as by email directed to the attorneys of record for the Petitioner at the following addresses:

sparmelee@wsgr.com
mrosato@wsgr.com
jmills@wsgr.com

By: / Courtenay C. Brinckerhoff /
Courtenay C. Brinckerhoff
Registration No. 37,288

Jason N. Mock
Registration No. 69,186

Counsel for Patent Owner
Foley & Lardner LLP